

**REMARKS**

The Examiner is thanked for the due consideration given the application. The specification has been amended to insert headings.

Claims 1-5, 8-10, 12, and 16-23 are pending in the application. Claims 1-5, 8-10, 12, 16 and 17 have been amended to improve their language in a non-narrowing fashion. Claims 18-21 are new and find support at page 6 of the specification. Claims 22 and 23 are new and find support at page 7 of the specification.

**Claim Objections**

Claims 8, 12 and 16 have been objected to as containing informalities. The comments in the Official Action have been considered, and the claims have been amended to be free from informalities.

**Rejections Based on ELLNER et al.**

Claims 1-5 and 17 have been rejected under 35 USC §102(e) as being anticipated by ELLNER et al. (U.S. Patent No. 6,618,328). Claim 16 has been rejected under 35 USC §103(a) as being unpatentable over ELLNER et al. in view of SEKIGUCHI (U.S. Patent 6,751,164). Claim 8 has been rejected under 35 USC §103(a) as being unpatentable over ELLNER et al. and SEKIGUCHI and further in view of SATO (U.S. Patent No. 6,657,922). Claim 9 has been rejected under 35 USC §103(a) as being unpatentable over

ELLNER et al., SEKIGUCHI and SATO and further in view of KOSAKA (U.S. Patent 4,348,751). Claim 10 has been rejected under 35 USC §103(a) as being unpatentable over ELLNER et al. Claim 12 has been rejected under 35 USC §103(a) as being unpatentable over ELLNER et al., NUSSBAUM (U.S. Patent No. 5,696,741) and TARDY (U.S. Patent 6,491,424). These rejections are respectfully traversed.

The present invention pertains to a back of a watch case that is typically illustrated, by way of example, in Figure 6 of the application, which is reproduced below.

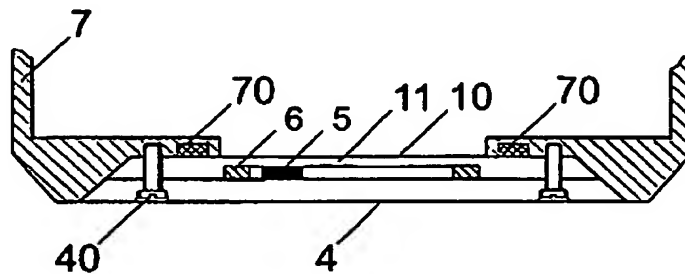
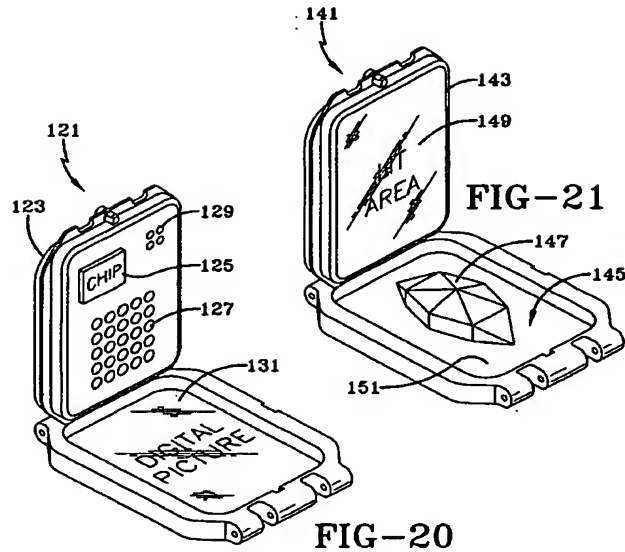


Fig. 6

Claim 1 of the present invention typically recites "a cover (4) that defines an external surface of the back;" and "a false back (11) installed against an internal surface of said cover, wherein an identification element (5, 6) is installed between said cover (4) and said false back (11)."

ELLNER et al. pertain to a watch. The Official Action refers to Figures 20 and 21 of ELLNER et al., which are reproduced below.



Concerning claim 1 of the present invention, the identification element is an electronic identification element called also a "transponder" composed only of an integrated circuit (5) and a coil (6). This identification element is completely isolated from the rest of the watch and hidden between the false back and the cover. It can only communicate with the external world by radio frequency via the coil and when excited by an external reader.

As written at page 3 of the specification:

This approach, moreover, has the advantage of allowing an electronic identification element to be placed between the cover and the false back. This identification element can be completely hidden between the cover and the false back. It has no adverse effect on the internal or external aesthetics of the watch and is completely protected against any damage, even in the case of opening the back.

In the ELLNER et al. case, the identification element is not the same as that defined in the present invention. For

example, ELLNER at al. at column 6, lines 50-65 discusses a "functional member 147" that can emit sound aroma, etc., but fails to disclose identification. The hidden compartment and its "false back" (so-called in the Official Action) have not the same functions as in the present invention.

In claims 2 and 3 of the present invention, the decoration on the false back is only for aesthetic reasons due to the implementation of the identification element in the watch. The technique of decoration is a kind of metal surface treatment. The definition of the decoration is completely different from the one interpreted by the Official Action (which can be the decoration of a speaker).

In claims 4 and 5 of the present invention, the attachment means of the false back and the cover to the middle are completely different from ELLNER et al.

In claim 16 of the present invention, the identification element is an electronic identification element called also a "transponder" composed only of an integrated circuit (5) and a coil (6). This kind of transponder is passive because it is not supplied by a battery. The integrated circuit is a specific circuit dedicated for the identification's application. There is no inference to replace this integrated circuit by sensor means/electronic circuit as suggested by the Official Action.

Furthermore, in the present invention, the identification element is a memory and contains the information of the watch. It allows, for example, to fight against falsification. In any case, it is not used to generate location information as thought by the Examiner.

Regarding claim 10 of the present invention, it is well-known that it is very difficult to read the information contained in the transponder when it is encapsulated in a metal case, for example, composed of a false back and the cover. The reason is that the metal strongly attenuates the transmission of radio frequency. A person having ordinary skill and creativity would thus fail to design an identification element working with a false back and a metallic cover.

The secondary references applied to assert unpatentability fail to address the above-described deficiencies of ELLNER et al.

ELLNER et al. thus fail to anticipate claims 1-5 and 17. One of ordinary skill and creativity would not produce claim 10 from a knowledge of ELLNER et al. Any combination of ELLNER et al. with the secondary references would fail to induce one of ordinary skill and creativity to produce a claimed embodiment of the present invention, and a *prima facie* case of unpatentability has thus not been made.

These rejections are believed to be overcome, and withdrawal thereof is respectfully requested.

Conclusion

The Examiner is thanked for considering the Information Disclosure Statement filed January 25, 2006 and for making an initialed PTO-1449 Form of record in the application.


Prior art cited but not utilized is believed to be non-pertinent to the instant claims.

The objections and rejections are believed to have been overcome, obviated or rendered moot, and that no issues remain. The Examiner is accordingly respectfully requested to place the application in condition for allowance and to issue a Notice of Allowability.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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